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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,766	11/18/2003	Iwan Wolf	DT-6666	5255
30377	7590	04/26/2005	EXAMINER	
DAVID TOREN, ESQ. SIDLEY, AUSTIN, BROWN & WOOD, LLP 787 SEVENTH AVENUE NEW YORK, NY 10019-6018			LOPEZ, MICHELLE	
			ART UNIT	PAPER NUMBER
			3721	

\* DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/715,766

Applicant(s)

WOLF ET AL.

Examiner

Michelle Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the amendment filed on February 17, 2005.
2. Claims 7-8 have been canceled.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolte (US 3,584,776) in view of Gschwend et al. (5,181,495), and further in view of Bade (US 3,320,860).

Bolte discloses a setting tool with a chamber 18; a piston guide 4; a drive piston 5; a magnetic piston-retaining means as a permanent magnet 16 for temporarily retaining the drive piston 5; and a magnetic flux-conducting element 13 for transmitting a magnetic holding force from the magnetic piston-retaining means 16 to the drive piston 5.

With regards to claim 1, Bolte discloses the invention substantially as claimed except for a combustion chamber for combusting a fuel-oxidation means mixture.

However, Gschwend et al teaches a combustion chamber 9 for combusting a fuel-oxidation means mixture for the purpose of driving a fastening element via an air fuel mixture being ignited (see Abstract). In view of Gschwend et al., it would have been obvious to one having ordinary skill in the art to have provided Bolte's invention with a

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combustion chamber 9 for combusting a fuel-oxidation means mixture in order to drive a fastening element via an air fuel mixture being ignited.

Also, with regards to claim 1, Bolte as modified by Gschwend et al. discloses the invention substantially as claimed except for a spacer formed as a shock-absorbing provided between the magnetic piston-retaining means and the drive piston.

However, Bade teaches a spacer 22a formed as a shock-absorbing element provided between or in an intermediate space of a magnetic piston-retaining means 22 and a drive piston 32, as the spacer 22a when not engaged by the driver piston 32 protrudes somewhat beyond the end face of insert 14 and 22 (see Fig. 2, and col. 2; 21-27) for the purpose of providing a cushioning member that reduces the impacting damage of the drive piston 32 over the magnetic piston-retaining means 22.

In view of Bade, it would have been obvious to one having ordinary skills in the art to have provided Bolte's invention as modified by Gschwend et al., and further having a spacer formed as a shock-absorbing provided between the magnetic piston-retaining means and the drive piston in order to cushioning the impact imparted by the drive piston over the magnetic piston-retaining means, thereby preventing wear and/or damage of the magnetic piston-retaining means.

With regards to claim 2, as Bolte discloses several magnets 16 positioned apart, it is deemed that each magnet 16 comprise a separate magnetic conducting element being associated with each magnet (see col. 1, lines 63-68).

Regarding claim 6, Bolte discloses that the magnetic flux-conducting element 13 is formed of a magnetic flux-conducting iron alloy, i.e. steel, as it is well known in the art that steel is a ferromagnetic material malleable alloy of iron (see col. 2, lines 20-23).

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4. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolte (3,584,776), Gschwend et al. (5,181,495) and Bade (3,320,860), an further in view of Averbukh (5,497,555).

Bolte as modified by Gschwend et al. and Bade discloses the invention substantially as claimed except that the magnetic piston-retaining means 16 comprises one electromagnet.

However, Averbukh teaches a magnetic piston-retaining means 132, i.e. an electromagnet, for the purpose of controlling the amount of current transmitted via the piston-retaining means 132 to the conducting element 130, thereby adapting the retaining force of the magnetic piston-retaining means 132 to the required operational conditions. In view of Averbukh, it would have been obvious to one having ordinary skills in the art to have provided Bolte's invention as modified by Gschwend et al. and Bade, and further having a magnetic piston-retaining means, i.e. an electromagnet, in order to control the amount of current transmitted via the piston-retaining means to the conducting element, thereby adapting the retaining force of the magnetic piston-retaining means to the required operational conditions.

Regarding claim 5, Bolte as modified by Gschwend et al. and Bade does not disclose that the magnetic flux-conducting element is formed as a pole piece.

However, Averbukh teaches a magnetic flux-conducting element 130 formed as a pole piece (see Fig. 3) for the purpose of controlling the magnetic force applied via the electromagnet 132 to the pole piece 130. In view of Averbukh, it would have been obvious to one having ordinary skills in the art to have provided Bolte's invention as modified by Gschwend et al. and Bade and further having a magnetic flux-conducting

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element formed as a pole piece in order to control the magnetic force applied via the electromagnet to the pole piece.

***Response to Arguments***

5. Applicant' arguments have been fully considered but they are not deemed persuasive.

Applicant contends that the combination of prior art does not disclose a spacer formed as a shock-absorbing element provided *between* the magnetic piston-retaining means and the drive piston.

*between*  
*adverb*

In an intermediate space, position, or time; in the interim.

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The claims are given their broadest reasonable interpretation and one could describe Bade as having shock-absorbing element 22a provided in an intermediate space of a magnetic piston-retaining means 22 and a drive piston 32, as the element 22a when not engaged by the drive piston 32 protrudes beyond the end face of 13 and 22.

6. For the reason above, the grounds of rejection are deemed proper.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

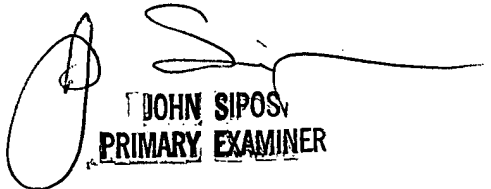
***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML

  
**JOHN SIPOS**  
**PRIMARY EXAMINER**